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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/713,744 | 11/15/2000 | Thomas P. Quigley | 61300/221 | 2947 |

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EXAMINER

SHAPIRO, JEFFERY A

ART UNIT PAPER NUMBER

3653

DATE MAILED: 03/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/713,744

Applicant(s)

QUIGLEY ET AL.

Examiner

Jeffrey A. Shapiro

Art Unit

3653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/16/03 has been entered.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-23 are rejected under 35 U.S.C. 102(e) as being anticipated by Skalla (US 6,367,606 B1). Skalla et al discloses the concrete transport vehicle and chute assembly as follows.

As described in Claims 1, 11 and 20;

1. a chassis having a front end and a rear end; (See col. 1, lines 10-15 of Skalla et al, which recites that the chute is for a "concrete truck".

Note also that US 4,054,194 to Davis and US 5,244,069 to Cosgrove, previously cited by Applicants, are referred to in col. 10, lines 26-29 of Skalla et al as having concrete chutes attached to concrete trucks, and each of these references show said concrete truck referred to in the present Claims 1, 11 and 20.)

2. a mixing drum supported by the chassis, the drum having a first end and a second end and an opening in communication with a discharge hopper and a main chute (see above);
3. a pedestal extending between the chassis and one end of the drum to support that end of the drum (note that it is inherent that a support must be provided for said drum—also, see above);
4. a cab enclosure supported by the chassis (note that it is inherent that there be a cab on said chassis—see above);
5. an extension chute (14 and 16) operatively aligned with the main chute (12), the extension chute comprising a chute assembly (see Claim 1, col. 4, lines 9-11);
6. a chute assembly comprising as follows;
 - a. a frame (12, 14 and 16) having a first end and a second end, each end including an arcuate end angle member (14 and 16) maintained in a spaced apart relationship by a pair of chute rails (12) attached to each end angled member;

- b. a chute skin (10) mounted within the frame and attached to each chute rail and each end angle member, wherein the chute assembly defines a longitudinally elongated concave chute;
- c. a removable liner (18) mounted within the chute assembly adjacent to the chute skin;

As described in Claim 2;

- 7. the mixing drum is configured to discharge concrete from an end (note that concrete trucks inherently have a discharge opening from which the concrete is extracted or poured);

As described in Claims 3, 12 and 20;

- 8. a hook (28) mounted on each chute rail (12) proximate the second end of the chute assembly and a bracket assembly (34) mounted on each chute rail proximate the first end of the chute assembly (see figure 1);

As described in Claims 4, 13 and 20;

- 9. the chute rails mounted on the chute are configured to releasably engage and support the liner (see col. 2, lines 48-50);

As described in Claims 5, 14 and 23;

- 10. the liner is composed of plastic (see col. 2, lines 50-52);

As described in Claims 6, 15 and 22;

- 11. the frame and chute skin are composed of aluminum (see col. 2, lines 52-67);

As described in Claims 7 and 16;

12. an elongated channel (22) attached to each end angle member and to the chute skin (see figure 1);

As described in Claims 8 and 17;

13. the elongated channel is composed of aluminum (see col. 2, lines 65-67);

As described in Claims 9, 18, 20 and 21;

14. the chute rails (12) are each configured, in conjunction with a liner flange (20) (see figure 3), to form a liner pocket to receive the liner and removably retain the liner within the extension chute;

As described in Claim 10;

15. the chute rail (12) and the liner flange (20) are composed of the same material and forms a single, integral member (see col. 2, lines 48-55);

Response to Arguments

4. Applicant's arguments filed 12/16/03 have been fully considered but they are not persuasive.

Affidavit Under 37 C.F.R. Sec. 1.131

5. The Affidavit and Declaration filed on 3/27/03 under 37 CFR 1.131 has been considered but is ineffective to overcome the prior art reference, US 6,367,606 B1.

The evidence submitted is insufficient to establish a reduction to practice of the invention in this country or a NAFTA or WTO member country prior to the effective date of the prior art reference.

The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the prior art reference to either a constructive reduction to practice or an actual reduction to practice.

The evidence submitted is insufficient to establish applicant's alleged actual reduction to practice of the invention in this country or a NAFTA or WTO member country after the effective date of the prior art reference.

The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the prior art reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897).

Applicant Scott Steckling asserts that on 9/3/99, he met with John Skalla, one of the inventors of the '606 patent, and that he signed a non-disclosure agreement upon sign in at the Oshkosh Truck facility, and that Skalla was made aware of various designs of Quigley et al and Oshkosh truck. See Declaration of Scott Steckling, filed 12/16/03.

These statements and the sign in of Skalla are, in and of themselves, not considered to provide sufficient evidence supporting overcoming the prior art cited.

Even if it is argued that Applicants' declarations exhibit proof of reduction or constructive reduction to practice, there is still not sufficient evidence to determine if Skalla et al reduced or constructively reduced to practice.

As there is no evidence that Skalla did not invent the claimed apparatus before Applicants of the instant application, and the evidence presented in the Affidavit, taken either individually or as a whole, do not comprise sufficient evidence of conception, due diligence or reduction to practice, the date of the prior art reference US 6,367,606 B1 is considered still valid, and the rejection under 35. USC Sec. 103 (a) is maintained.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey A. Shapiro whose telephone number is (703)308-3423. The examiner can normally be reached on Monday-Friday, 9:00 AM-5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald P. Walsh can be reached on (703)306-4173. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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Jeffrey A. Shapiro
Examiner
Art Unit 3653

March 1, 2004



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